

REMARKS/ARGUMENTS

Favorable reconsideration of this application is respectfully requested.

Claims 1, 3, 5-9, 11, 13-17, 19, 21-25, 27, and 29-44 are pending in this application. Claims 1, 3, 5-9, 11, 13-17, 19, 21-25, 27, and 29-44 were rejected under 35 U.S.C. § 112, first paragraph. Claims 1, 5, 7, 9, 13, 15, 23, 37, and 39 were rejected under 35 U.S.C. § 103(a) as unpatentable over U.S. patent 5,341,154 to Bird, U.S. patent 6,029,076 to Fiddian-Green et al. (herein "Fiddian-Green"), U.S. patent 6,313,851 to Matthews, III et al. (herein "Matthews"), and further in view of U.S. patent 5,208,736 to Crooks et al. (herein "Crooks"). Claims 8, 16, 17, 21, 24, 25, 29, 31, 33, 35, 41, and 43 were rejected under 35 U.S.C. § 103(a) as unpatentable over Bird, Fiddian-Green, Matthews, Crooks, and further in view of U.S. patent 6,552,738 to Lin et al. (herein "Lin"). Claims 3, 6, 11, 14, 38, and 40 were rejected under 35 U.S.C. § 103(a) as unpatentable over Bird, Fiddian-Green, Matthews, Crooks, and further in view of U.S. patent Des. 409,583 to Nishida et al. (herein "Nishida"). Claims 19, 22, 27, 30, 32, 34, 36, 42, and 44 were rejected under 35 U.S.C. § 103(a) as unpatentable over Bird, Fiddian-Green, Matthews, Crooks, Nishida, and further in view of Lin.

Initially, applicant and applicants' representative wish to thank Examiner Caschera for the interview granted applicants' representative on August 23, 2005. During the interview the outstanding rejections were discussed in detail. Further, during the interview claim amendments were discussed to clarify claim features over the applied art. The present response sets forth the discussed claim amendments. During the interview Examiner Caschera indicated such amended claims appear to address the current rejections, but would be further considered in view of the filed response and in view of an update search.

Addressing now the rejection of claims 1, 3, 5-9, 11, 13-17, 19, 21-25, 27, and 29-44 under 35 U.S.C. § 112, first paragraph, that rejection is traversed by the present response.

The above-noted rejection is based on the position that the claim language “when the back surface of said display body is close to said main body the second operating means is positioned on an opposite of the display screen as the at least first operating means” was not clearly supported by the specification.

In response to the above-noted rejection, applicants first note the claim language is amended by the present response to clarify features therein. Specifically, the claims as currently written now clarify the first operating means and second operating means positioned on opposite “left or right” sides of the display screen. As shown for example in Figure 7C and 7D in the present specification, the first operating means, see as a non-limiting example buttons B1-B4, and the second operating means, see as a non-limiting example dial 32, are positioned on opposite left or right sides of the display screen. Thus, applicants submit the claim language is fully supported by the original specification, as agreed to during the interview.

Addressing each of the above-noted rejections, those rejections are traversed by the present response.

As discussed during the interview, the claims now further clarify a structure of the position of the first and second operating units and means in a condition in which a back surface of the display body is close to the main body, e.g. in a photographing mode. Specifically, claim 1 now recites that in such a condition “the second operating means is positioned on an opposite left or right side of the display screen as the first operating means”; the other independent claims recite similar features. Such subject matter is fully supported by the original specification for example in Figures 7C and 7D. In the operation shown in those figures the second operating device, e.g. the control dial 32, is on an opposite left or right side of the display screen as the first operating device, e.g. the control buttons B1-B4. With such a structure, the claimed invention allows a simple operation by a user of the first and second

operating devices of the computer with his or her fingers as he or she holds the computer with both hands.

Such a structure in the claims clearly differs from the teachings in the applied art.

Specifically, Bird shows in Figure 5 the condition in which the back surface of the display screen is close to the main body, and it is clear in that Figure 5 in Bird that no second control is positioned on an opposite left or right side of a display screen as a first control. As a result, in the device of Bird a user has to hold the device with one hand and then operate the stylus or track ball with another hand. Such a structure in Bird does not allow a simple operation of two different control elements while an operator can still hold a computer with his or her hands. Thus, Bird clearly differs from the claims as currently written.

Further, the applicants of the present invention recognized that an enhanced device can be realized with the positioning and use of the first and second operating units. With the claimed structure, even if a display screen is close to a keyboard, an operator can still properly and efficiently utilize the claimed device. None of the applied art teach or suggest the specific combinations of features that realize such benefits. It is only the applicants of the present invention that recognized such benefits in the claimed structure to realize such benefits. The taking of the isolated teachings in the applied art does not teach or suggest the claimed features and would not have been suggested in the manner relied upon in the Office Action.

Moreover, no teachings in the further cited references are believed to overcome the above-noted deficiencies of Bird.

The pending claims also include dependent claims 37-44 for examination, which are believed to further distinguish over the applied art. Dependent claim 37 further recites:

wherein said first operating means includes a set of operating buttons, said second operating means includes a control dial, and said set of operating buttons is dedicated for only displaying of the system menu showing processing items.

The other dependent claims 38-44 recite similar limitations. Such features are believed to further distinguish over the applied art.

The above-noted features are fully supported by the original claims and also in Figure 2 as a non-limiting example. As shown in Figure 2 a dial 32 is provided on the display body but outside of the display screen and operates independently of contact with the display screen. That is, the dial 32 does not require any element to contact the display screen 31 to operate. Further, in Figure 2 the set of buttons B1-B4 is provided outside of the display body. Further, that set of buttons B1-B4 is dedicated only for displaying the system menu showing processing items. That is, those buttons B1-B4 do not have any other operations, which is believed to be clear from the original disclosure.

The outstanding rejection appears to rely on the numeric keypad 40 in Bird to correspond to the above-noted claimed “set of operating buttons” and to rely on the track ball or sphere assembly 50 in Bird to correspond to the now claimed “control dial”. In that respect applicants first note Bird further clearly differs from new claims 37-44 as currently written. In those claims as currently written a set of dedicated buttons is provided to display a system menu showing processing items. Clearly the numeric keypad 40 in Bird does not provide such a function, at the very least because that numeric keypad 40 is used for varying and different operations rather than displaying a system menu showing processing items. Further, clearly the track ball in Bird differs from the further noted claimed features as that track ball is not a dial, and is not provided on a displayed body but outside of and operating independently of contact with the display screen.

One basis for the outstanding rejection now cites Fiddian-Green to disclose utilizing a computer keypad for selecting operation modes for a menu of a computer. In that respect applicants first note such a keypad in Fiddian-Green does not correspond to the claimed “set of operating buttons” which are dedicated for only controlling displaying a system menu showing

processing items. Thus, Fiddian-Green cannot overcome the above-noted deficiencies of Bird which respect to that claim feature.

Further, with respect to the teachings in Matthews, Matthews does not disclose or suggest the claimed “dial”, and particularly where the dial has an operation “for selecting a processing item to be executed from said system menu”. In the claimed invention the dial operates to control a selection of one of processing items displayed based on an operation of the dedicated set of operating buttons. Matthews clearly fails to teach or suggest such features, and thus no combination of teachings of Matthews with Bird and Fiddian-Green would teach or suggest features. Again, Matthews also does not even disclose or suggest the use of a dial.

Further, the teachings in Crooks are merely directed to embedding a track ball into a display, but such teachings in Crooks cannot overcome the above-noted deficiencies of Bird, Fiddian-Green and Matthews, and applicants also note that Crooks clearly does not disclose or suggest the use of a dial.

One basis in the outstanding rejections also cites the teachings in Nishida with respect to a dial and states “[n]ote, in reference to claim 14, the Office interprets the sphere functionally equivalent to the dial of Applicant’s claim”.¹

In that respect, applicants note Nishida does not disclose or suggest the claimed dial that is part of a display screen, and thus no combination of teachings of Nishida in view of Bird, Fiddian-Green, Matthews, and Crooks would render obvious all the claim limitations. In that respect, applicants also note that if one of ordinary skill in the art was to combine the teachings of Nishida with the teachings in Bird, Fiddian-Green, Matthews, and Crooks, then one of ordinary skill in the art would use a track ball in Nishida outside of a display body as that is what Nishida teaches. It is unclear how the outstanding Office Action would

¹ Office Action of June 9, 2005, page 12, first full paragraph.

otherwise take an isolated teaching in Nishida to combine with the teachings in the other noted references.

Stated another way, Nishida discloses a structure contrary to the claimed features in that Nishida discloses a track ball as attached to a keyboard. In that respect, the sphere in Nishida is not at all even similar to the “control dial” of the claims, which is “provided on the display body but outside of and operating independently of contact with said display screen”. One of ordinary skill in the art would not take only isolated teachings from Nishida and combine such with the teachings in Bird, Fiddian-Green, Matthews, and Crooks and arrive at the claimed invention.

In maintaining the outstanding rejection to claims 37-44 the outstanding rejection appears to indicate that it would have been obvious to one of ordinary skill in the art to modify Bird, and presumably the other references, to meet the claim limitations because the claimed features were seen as a design choice decided/preferred by the designer and as “[t]he explicit assignment of these buttons to specific functions *could* easily be modified, using software or hardware means, to allow for the keypad buttons to perform various operations...” (emphasis added).²

In response to the above-noted basis for the rejection, applicants submit that a proper *prima facie* case of obviousness has not been made with respect to claims 37-44.

As noted M.P.E.P. § 2143:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claimed limitations.

² Office Action of June 9, 2005, top of page 18.

The teachings or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicants' disclosure.

M.P.E.P. §2143 also indicates that the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.

Applicants respectfully submit, with respect to claims 37-44, a *prima facie* case of obviousness has not been established as the combination of teachings in the cited art does not fully meet the claim limitations, and there is no suggestion to modify the prior art to fully meet the claimed limitations in the references themselves. The only motivation indicated even in the Office Action to modify the prior art to meet the claim limitations is applicants' own disclosure of the benefits of the present invention.

Further, the mere fact that the prior art *could* easily be modified (as stated in the Office Action) to meet the claim limitations is not a proper basis for a rejection under 35 U.S.C. § 103.

Thus, dependent claims 37-44 are believed to further distinguish over the applied art.

As no other issues are pending in this application, it is respectfully submitted that the present application is now in condition for allowance, and it is hereby respectfully requested that this case be passed to issue.

Respectfully submitted,

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